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IN THE

Supreme Court of the United States

OCTOBER TERM 1973

No. 73-187

KEWANEE OIL COMPANY,
Plaintiff-Petitioner,

v.

BICRON CORPORATION ET AL,
Defendants-Respondents.

MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE IN SUPPORT OF THE PETITION FOR WRIT OF CERTIORARI

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Licensing Executives Society

FIDELITY PRINTING COMPANY, HOUSTON

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The Licensing Executives Society of the United States moves for leave to file a brief amicus curiae in support of issuance of a Writ of Certiorari. The subject brief accompanies the motion.

The Society has requested consent of the parties to file such a brief. Consent of Petitioner is attached as Appendix A hereto, the original having been filed with the Clerk. Respondent has refused to consent to the filing of a brief by the Society. A copy of the refusal is attached as Appendix B, the original having been filed with the Clerk.

The interest of this amicus is focused as much on the granting of the writ of certiorari as upon the merits; hence the amicus files this motion for leave to support the petition for writ.

1. Nature of the amicus curiae

The Licensing Executives Society is a professional association of persons who are intimately involved in licensing of technology and industrial property rights, including trade secrets and know-how.

The Society in the United States is composed of about 900 members, some members representing large corporations; others representing small companies; some being private practitioners of the law.[1]

Inherent in the work of the Society's members is continuing contact with the financing and generation of new technology, with procedures to protect the technology developed, and with the interrelation between the necessity of protection and the ability to obtain financing.

2. Interest of this amicus

Know-how technology in the United States is a multi-billion dollar asset of U. S. industry. Payments for the licensed portion of that asset run over a billion dollars annually, millions each day.

The decision below conflicts with the law in other circuits and with state case law and statutes, upon which law contracts and business practices worth many millions of dollars have been built by the members of this amicus for their clients and employers.

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[1] While there are now in addition to the 900 persons referred to above who are U.S. citizens, also foreign chapters and members of the Licensing Executives Society, Inc., reorganization is already in process for final ratification at the October 1973 annual convention, by which the United States members will be formalized into their own nonprofit corporation independent of foreign chapters. This brief is sponsored only by the United States group, acting through the Board on advice of the Committee on Laws.

Since the opinion below endangers a principal stock in trade of the members of this amicus, namely trade secrets, they are intensely interested.

3. The role of the amicus in this case

The opinion below was written

(a) without apparent familiarity with the billion dollar size of the annual business transacted in trade secrets within the scope of the rule announced in the opinion;

(b) without apparent familiarity of the nature of the market for trade secrets (i) in know-how licenses, or (ii) in subcontracts, or (iii) in contracts for R & D;

(c) without apparent familiarity of the need for trade secret protection as an absolutely necessary supplement to patent protection, as a vital part of the overall sponsorship of progress in the useful arts;

(d) without apparent knowledge that the rule of the opinion would cut off a billion dollar order of magnitude of international balance of payments credit which the country sorely needs at a time when the dollar is suffering as it is now on international money markets;

(e) without apparent cognizance that the rule of the opinion below will cut United States industry off from access to perhaps a hundred million a year in purchases of foreign know-how that is important to our industry's capacity to serve our society.

These factors, not mentioned by the Court below, are all what Mr. Justice Frankfurter referred to as "the realities of law in action". This amicus, because of its nature and experience, can provide the realities of trade secret law in action upon billions of dollars in national assets.

Similarly, members of this amicus carry the ongoing responsibility of negotiating and administering millions of dollars of new know-how license contracts annually. When a new law of such fundamental importance is being made, participation by interested amicus curiae is the nearest thing afforded in judicial procedure to obviously desirable public hearings.

The Licensing Executives Society respectfully requests leave to file, as amicus curiae, the accompanying brief urging issuance of a writ of certiorari.

Respectfully,

TOM ARNOLD
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(713) 621-9100

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Licensing Executives Society

APPENDIX A

ARNOLD, WHITE & DURKEE
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June 20, 1973

FILE H409

Mr. Edward P. Troxell
Jones, Day, Cockley & Reavis
1750 Union Commerce Building
Cleveland, Ohio 45115

Re: Kewanee Oil Company v. Bicron Corp. et al

Dear Mr. Troxell:

On behalf of the Licensing Executives Society, I ask leave of Kewanee Oil Company to file a brief amicus curiae in the United States Supreme Court in support of the Kewanee Oil Company petition for writ of certiorari and also on the merits of the case.

If you will consent to the filing of such a brief amicus I will appreciate your so indicating on the enclosed two copies of this letter. Please return them to me for filing in the United States Supreme Court with the briefs on behalf of the Licensing Executives Society, Inc.

Yours truly,

Tom Arnold

Tom Arnold

TA: ef

CONSENT

Kewanee Oil Company, Plaintiff-Petitioner, hereby consents to the filing of an amicus brief by the Licensing Executives Society both in connection with the petition for writ of certiorari and upon any hearing on the merits.

Edward P. Troxell

Counsel for Kewanee Oil Company

APPENDIX B

BOSWORTH, SESSIONS & McCOY
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ROY F. HOLLANDER
CARL A. RANKIN
NEIL A. DUCHEZ

July 23, 1973

Tom Arnold, Esq.
Arnold, White & Durkee
2100 Transco Tower
Houston, Texas 77027

Re: Kewanee Oil Company vs. Bicron Corporation et al.

Dear Mr. Arnold:

This confirms our telephone conversations and responds to your June 20 letter.

Bicron will not consent to the filing of an amicus curiae brief by the Licensing Executives Society in connection with the Kewanee petition for certiorari.

As we read Supreme Court Rule 42(1), such briefs are not favored. In the event you file a motion for leave to file such a brief, then Bicron will not oppose it.

Should the Supreme Court grant the petition, we will then deal with the second aspect of your request, which is to file a brief amicus curiae on the merits. Our present inclination is to consent to the filing of any such brief, or at least not oppose it, provided it is filed within the time allowed for the filing of Kewanee's brief so that we can respond to it. We assume your brief will support the position of Kewanee.

Very truly yours,

WCMJR:sam
G-6244

RECEIVED
JUL 24 1973
A. W. & D.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that copies of the foregoing were on this 30th day of July, 1973 mailed by regular airmail to counsel for Petitioner and Respondents as follows: Mr. Edward P. Troxell, Jones, Day, Cockley and Reavis, 1750 Union Commerce Building, Cleveland, Ohio, 44115; Mr. Roger Milgrim, Milgrim, Tomajan and Jacobs, 25 Broadway, New York, New York, 10004; Mr. William C. McCoy Jr.. Bosworth, Sessions & McCoy, 625 National City Bank Bldg., Cleveland, Ohio, 44114.

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